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means for determining, based on a state of said recording medium, whether a recording operation of said image data recording processor is possible; and

means for controlling said transmitting means and said recording means, said control means prohibiting said recording operation and allowing said image data transmitting means to transmit said image data to said computer when said determining means determines that said recording operation is impossible.

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REMARKS

Initially, Applicant would like to express appreciation to the Examiner for the detailed Official Action provided, for the acknowledgment of Applicant's Information Disclosure Statement by return of the Form PTO-1449, and for the acknowledgment of Applicant's Claim for Priority and Receipt of the certified copy of the priority documents in the Official Action.

Upon entry of the present amendment, the drawings and specification will have been amended and claim 12 will have been amended to correct a grammatical error therein. Claims 1-12 remain pending in the present application.

The Examiner has objected to the drawings, suggesting that in Fig. 1, reference character "R" should be added to the "Recording Medium" block of this figure. In compliance with the Examiner's suggestion and as noted *supra*, Applicant has submitted an amended drawing sheet for Fig. 1. Applicant is concurrently submitting a Request for

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Approval of Drawing Amendment with the changes indicated in red therein. Also submitted herewith is a corrected formal drawing for Fig. 1, as Applicant assumes that the Examiner will approve the minor changes in the concurrently-submitted Request for Approval of Drawing Amendment. It is thus respectfully requested that the Examiner withdraw the objection to the drawings.

The Examiner has objected to the specification, requiring the correction of a minor grammatical error. In compliance with the Examiners requirement, Applicant has amended the specification at the appropriate place, and thus respectfully requests that the Examiner withdraw the objection to the specification.

The Examiner has also objected to claim 12, requiring the correction of a minor grammatical error. In compliance with the Examiners requirement, Applicant has amended claim 12 at the appropriate place, and thus respectfully requests that the Examiner withdraw the objection to this claim.

The Examiner has rejected claims 1-5, 10 and 12 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,315,403 to HIRAI, finding that this reference teaches all limitations of these claims.

Applicant respectfully traverses the Examiner's rejection. Applicant submits that HIRAI, as well as the other references of record, are markedly different from the present claimed invention. First, we note that contrary to the Examiner's assertion, HIRAI *does not*

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disclose an image data processor that can transmit image data *externally* to a peripheral device as claimed in claim 1 (emphasis added). Nor does HIRAI disclose transmitting image data to a computer *provided externally* to the image reading device. Rather, HIRAI is directed to a facsimile machine having a two systems for storing data, *i.e.*, RAM 30 (having a high storage speed) and a floppy disk drive FDD (having a low storage speed), both being a part of the facsimile machine itself. While Applicant acknowledges that the floppy disk FD of HIRAI may be removed and thus may be made external, the floppy disk itself is merely a *storage medium* and is not a “peripheral device” (as claimed in independent claim 1), nor is it a “computer provided externally” to the image reading device (as claimed in independent claim 12). Thus, with such a configuration HIRAI cannot transmit data *externally* to a peripheral device (as claimed in independent claim 1) or to a “computer provided externally” to the image reading device (as claimed in independent claim 12).

Further, even if the Examiner were to (incorrectly) maintain the position that either the floppy disk FD or floppy disk drive FDD of HIRAI were either an external “peripheral device” or a “computer provided externally” to the image reading device, HIRAI further fails to teach or disclose a control processor that prohibits the recording operation and allows image data to be transferred to the peripheral device (as claimed in independent claim 1) or to the computer (as claimed in independent claim 12), when it is determined that the recording operation is impossible.

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Rather, HIRAI works in an opposite manner. Specifically, as described for example in col. 1, line 66 - col. 2, line 4, when the quantity of image information in the first storage medium (RAM 30) becomes greater than the blank memory capacity of the second storage medium (floppy disk FD), the reception of the image is suspended, and the image information is not received. In other words, the image information *is not* sent to the floppy disk when the recording operation is impossible. In the present claimed invention, when the recording operation is impossible, image data is sent to the peripheral device in independent claim 1, and to the computer in independent claim 12.

It is therefore respectfully submitted that HIRAI, as well as the other references of record, fails to teach or disclose the invention of independent claims 1 and 12, as well as the claims dependent therefrom.

With respect to the Examiner's rejection of dependent claims 2-5 and 10 under 35 U.S.C. § 102(e), since these claims are dependent from allowable independent claim 1, which is allowable for at least the reasons discussed *supra*, these dependent claims are also allowable for at least these reasons. Further, all dependent claims recite additional features which further define the present invention over the references of record. It is thus respectfully submitted that all rejected claims are patentably distinct from the references of record.

Absent a disclosure in a single reference of each and every element recited in a claim,

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a *prima facie* case of anticipation cannot be made under 35 U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claims 1 and 12, and the claims dependent therefrom, these claims are not anticipated thereby. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 102(e).

With respect to the Examiner's rejection of dependent claims 6-9 and 11 under 35 U.S.C. § 103(a), as these claims are dependent from allowable independent claim 1 which is allowable for at least the reasons discussed *supra*, these dependent claims are also allowable for at least these reasons. Further, all dependent claims recite additional features which further define the present invention over the references of record. Accordingly, the Examiner is respectfully requested to withdraw all rejections under 35 U.S.C. § 103(a).

Thus, Applicant respectfully submits that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. §§ 102 and 103, and respectfully requests the Examiner to indicate the allowance of each and every pending claim in the present application.

#### SUMMARY AND CONCLUSION

In view of the fact that none of the art of record, whether considered alone, or in any proper combination thereof, discloses or suggests the present invention, reconsideration of the Examiner's action and allowance of the present application are respectfully requested and are believed to be appropriate.

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The amendment to claim 12 has been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
Yasuhiro YAMAMOTO

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**MARKED-UP COPY OF THE PARAGRAPH OF THE SPECIFICATION**

Please amend the paragraph on page 12 beginning line 16 and ending line 20, as follows:

---In Step 112, a stand-alone flag is set to 1, and in Step 113, a message, implying that the operations of both [of] the stand-alone mode and the remote mode can be performed, is indicated on the display panel 52 (Figs. 1 and 4). An example of the message is shown by reference E1 in Fig. 7A.---

**MARKED-UP COPY OF CLAIM 12**

12. (Amended) An image reading device comprising:

[means for optically reading] a device that optically reads an image recorded on a recording material sheet to generate image data;

[means for transmitting] a device that transmits said image data to [an] a computer provided externally to said image reading device;

[means for determining] a device that determines, based on a state of said recording medium, whether a recording operation of said image data recording processor is possible; and

[means for controlling said transmitting means and said recording means, said control means] a device that controls and transmitting device and said recording device, said device controls prohibiting said recording operation and allowing said image data transmitting [means] device to transmit said image data to said computer when said determining device determines that said recording operation is impossible.